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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/052,669	01/18/2002	Li-Wei Hsu	205032000700	5533

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MORRISON & FOERSTER LLP
3811 VALLEY CENTRE DRIVE
SUITE 500
SAN DIEGO, CA 92130-2332

EXAMINER

BISSETT, MELANIE D

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 10/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/052,669

Applicant(s)

HSU ET AL.

Examiner

Melanie D. Bissett

Art Unit

1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5,7,8,12-14 and 16-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5,7,8,12-14 and 16-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 7/30/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

1. The rejections based on 35 USC 112, 102, and 103 have been withdrawn based on the applicant's amendments. However, new double patenting rejections have been added.

Double Patenting

2. Claims 1-4, 7-8, and 12-14 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2 and 5-11 of U.S. Patent No. 6,645,719 B2. Although the conflicting claims are not identical, they are not patentably distinct from each other because of substantially overlapping subject matter. Patented claim 1 is a narrower reading of present claim 1, where the patented claim is directed to an intended use of immobilizing herb components and specifies that the slide contains independently allocated microarrays on the coating. However, the patented claim is encompassed by the present claim. Due to substantial overlapping subject matter, it is the examiner's position that the claims are not patentably distinct. Patented claims 2 and 5-11 teach the features of present claims 2-4, 7-8, and 12-14.
3. Claims 1-5, 7-8, 12-14, and 16-21 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2-3, 5, 7-11, 13-15, and 17-22 of copending Application No. 10/233,235. Although the conflicting claims are not identical, they are not patentably distinct from each other because of substantially overlapping subject matter. Copending claim 7 is drawn to a plastic slide useful for immobilizing proteins, peptides, and small molecules,

where the slide is surface treated to have a polyfunctional aldehyde coupled to a compound having an NH₂ group and a subsequent coating. Copending claim 11 teaches a polyfunctional epoxide coating for the slide, where the epoxide is inherently capable of reacting with NH₂ groups and proteins, peptides, or small molecules. It is the examiner's position that it would have been prima facie obvious to combine the limitations of copending claims 7 and 11 to form a slide capable of sufficiently immobilizing such materials. Copending claims 2-3, 5, 7-10, and 13-15 teach the limitations of present claims 2-5, 7-8, and 12-14.

4. Furthermore, copending claim 17 is a narrower reading of present claim 16, where the copending claim further limits the slide to have at least one cavity chamber having a specific depth. However, the copending claim is encompassed by the present claim. Due to substantial overlapping subject matter, it is the examiner's position that the claims are not patentably distinct. Copending claims 18-22 teach the features of present claims 17-21.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

5. The prior rejections have been withdrawn based on the applicant's amendments. However, new double patenting rejections have been added.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melanie D. Bissett whose telephone number is (571) 272-1068. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**MELANIE BISSETT
PATENT EXAMINER**

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